MECHANICS OF PATENT CLAIM DRAFTING

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popper and is to be so claimed, and that the holes in the container (Fig. 1) are important and must be defined.

Clause (a) of Claim 1 might read:

> A container for receiving kernels of corn to be popped, the container having a perforated bottom with apertures smaller in size than the kernels;

Other examples of expressions defining features of elements:

> a disc of resilient material having a peripheral groove . . .
> a relay having two windings . . .
> a lever having a forked end and a rounded end . . . [If only the forked end is important to the combination being claimed, do not mention the rounded end.]
> a gear of electrically insulating material . . .

If an element by definition inherently includes a certain feature, such feature need not be recited and it is proper to refer, without previous mention, to such features as:

> the end of the lever . . .
> the periphery of the disc . . .
> the tines of the fork . . .

In case of doubt, positively describe the feature or part.

SUMMARY—Select those parts or features of each element that are essential to the combination being claimed. Then, describe them in a logical order, preferably following the main description of the element in the same clause of the claim. How many features need to be described and how broadly each should be recited is a matter of claim scope (based largely on the prior art), but the principles are the same as used in selecting the elements and naming them.

Section 23—Claiming Holes

In the situation where a hole is to be described it must not be recited positively. That is, instead of stating "a hole, groove, aper-

ture, recess, slot, etc., in the lever," one must state ". . . the lever having a hole, groove, etc." Thereafter, one can refer to "the hole" or "said hole." This "rule" may seem to make little sense, but it is another founded in antiquity like the single-sentence rule. Maybe someone thought that a hole is nothing—and people shouldn't claim nothing?

Another approach to describing holes is an expression such as ". . . the level having portions defining a hole, groove, etc." The hole is thus defined in terms of the structure which forms it.

One case *In re Newton*, 163 USPQ 34 (CCPA 1969), held that it was proper to claim a hole and its function as a means for performing a function, specifically "means for providing fluid communication between . . . [two members]."

SUMMARY—Do not claim holes positively or make them claim elements. Holes are nothing; you cannot claim nothing. Claim "a [member] having a hole," groove, slot, aperture, etc.

Section 24—Order of Elements

The elements of the claim should be presented in some logical order. Often, there are several orders that make sense, and any one may be selected. The order used in Claim 1 is a "functional" order, starting with the element which first contacts the workpiece (the container) and proceeding along functional lines to describe the remaining elements.

Another order which is often used is a "structural" order, starting first with the base, or the source of power, and proceeding along structural lines to describe the remaining elements. In structural order, Claim 1 would read:

> **1B. Apparatus for shaking articles, which comprises:**
> **(a) a base;**
> **(b) a plurality of parallel legs, each of which is connected pivotally at one end of the base;**
> **(c) a container for the articles connected pivotally to the other ends of the legs, so that the legs support the container for oscillating movement with respect to the base; and**